



4-26-04

1763

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Michael C. Rushford et al Docket No.: IL-10738
Serial No. : 10/087,493 Art Unit: 1763
Filed : February 28, 2002 Examiner: Roberts P. Culbert
For : Method and System for Optical Figuring by Imagewise Heating of a Solvent

Commissioner for Patents
Alexandria, VA 22313-1450

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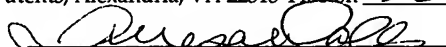
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RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Alexandria, VA 22313-1450

Dear Sir:

In response to the restriction requirement mailed March 23, 2004,

Applicants elect with traverse, Group I, claims 1-6, 8-20, 22-29, and 31-33. The Examiner stated that the inventions of Groups I, II, and III are distinct from each other. Between Groups I (method) and III (apparatus) in particular, the Examiner cited MPEP Sec. 806.05(e), stating that inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another

and materially different process. Pursuant to condition (2) above, the Examiner stated that the process and apparatus claims are distinct because, *"the apparatus as claimed can be used to practice another and materially different process such as a non-parallel process"* (emphasis added).

It is respectfully submitted, however, that the restriction between Groups I and II is improper because neither of the two conditions of MPEP Sec. 806.05(e) are met. Contrary to the Examiner's assertion, the apparatus cannot be used to practice another and materially different process such as a non-parallel process. Independent claim 34 of Group III, has a single element: *"means for generating a local thermal gradient in each of a plurality of selected local regions of a boundary layer of the etchant solution to imagewise etch the substrate surface in a parallel process"* (emphasis included). As underscored above, this means-plus-function clause includes, as descriptions of function, the limitations of *"for generating"* and *"to imagewise etch,"* both of which constitute a substantive part of the definition of the *"means."* The Examiner, however, has apparently erred by not giving proper consideration to the *"to imagewise etch"* language as a substantive limitation. Had he done so, paragraph 20 on page 7 of the Specification would have clearly delineated a parallel etching process, as follows:

"...It is appreciated that the term "imagewise" describes a parallel process where etching takes place concurrently or simultaneously at a plurality of local target regions of the substrate surface, similar to the use of a branding iron."

The reading of “to imagewise etch” as a substantive limitation of the “means” finds support in the CCPA holding of *In re Chandler* 117 USPQ 361 (CCPA 1958), which addressed the issue of when clauses are properly included in the definition of a “means” element, and in particular the following clause:

“and means responsive to said movement for regulating the propulsive power of said engine, in accordance with said movement, so that said aircraft is propelled at a definite, selected speed, corresponding to the position of said engine relative to said aircraft, throughout the speed range of said aircraft” (emphasis added).

As stated by the CCPA in *In re Chandler*:

“We are of the opinion that the expression beginning with “so that” is not merely functional, but constitutes a part of the definition of the “means responsive to said movement.”... Such a definition conforms to the provision of 35 USC Section 112 that an element in a claim for a combination “may be expressed as a means or set for performing a specified function without the recital of structure, material or acts in support thereof.”

Applicants respectfully submit that the “means for [doing something]... to [do something]” claim structure of Claim 34 is analogous to and a functional equivalent of the “means for [doing something]... so that [something is done]” claim structure of *In re Chandler*. As such, it is submitted that *In re Chandler* controls and is determinative with respect to claim construction of the apparatus claims of the present invention, with novelty and non-obviousness of the system (apparatus) claims examined in the means clause taken as a whole, including the specified “to imagewise etch” limitation, and not simply in the “means for generating a local thermal gradient” clause alone.

Similarly, and with respect to condition (1) of MPEP Sec. 806.05(e) mentioned above, Applicants respectfully submit that the process as claimed in independent claim 1 of Group I, for example, cannot be practiced by another materially different apparatus or by hand. Independent claim 1, includes the step of *"generating a local thermal gradient in each of a plurality of selected local regions of a boundary layer of the etchant solution to imagewise etch the substrate surface in a parallel process."* Analogous to the "means" discussion above for apparatus claims, it is submitted that step-plus-function clauses of process claims also follow *In re Chandler*. Thus in a "step for [doing something] ... to [do something]" clause of a method claim, the expression following "to" is also considered a substantive limitation of the step. As such, it is respectfully submitted that the process of claim 1 cannot be practiced by another materially different apparatus or by hand, since *"to imagewise etch"* is also a substantive limitation of the apparatus.

Moreover, it is submitted in light of the above discussion, that the field of search is the same between Groups I and III, and therefore a restriction between Groups I and II would require a second unnecessary search of the same art. It is therefore respectfully submitted that the restriction requirement between Groups I and III, is improper and should be withdrawn.

Respectfully submitted,

Dated: 4-23-04

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